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In re Application of : DECISION ON
HÖSS, Wolfgang :
Application No.: 10/554,970 :
PCT No.: PCT/EP04/01615 : PETITION
Int. Filing Date: 19 February 2004 :
Priority Date: 28 April 2003 : UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 14603-016US1 P2003,0256US :
For: FLIP-FLOP CIRCUIT ASSEMBLY :

This decision corrects the erroneous application and background information of the decision mailed 15 May 2007. The period to respond to this decision is reset to start with the mailing date of this decision.

This is a decision on applicant's "Petition Under 37 C.F.R. 1.47(b)," filed in the United States Patent and Trademark Office on 05 February 2007 on behalf of the assignee and the non-signing inventor Wolfgang Höss. The petition under 37 CFR 1.47(b) is DISMISSED.

BACKGROUND

On 19 February 2004, applicant filed international application PCT/EP04/01615, claiming a priority date of 28 April 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 October 2005.

On 27 October 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied, *inter alia*, by the requisite basic national fee.

On 05 September 2006, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 05 February 2007, applicant submitted the declaration, the surcharge for late filing of the declaration, a three-month extension fee, the present petition under 37 CFR 1.47(b) requesting acceptance of the application without the signature of the applicant and, a "Statement of Facts" to support the petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

With regard to item (1), in view of petitioner's authorization, the requisite fee of \$200 under 37 C.F.R. 1.17(g) has been charged to petitioner's Deposit Account No. 06-1050.

With regard to item (2), the copies of letters mailed by Mr. Martin Brand and Mr. Wilhelm Epping, the declarations of Ms. Tabea Strassner and Mrs. Karin Kammerer-Feigs and, the copies of the delivery receipts are appropriate to show that non-signing inventor Wolfgang Höss refuses to execute the application.

With regard to item (3), the "Statement of Facts" lists the last known address of non-signing inventor Wolfgang Höss as: Dr.-Lemischstrasse 15, A-8054 Graz, Austria.

With regard to item (4), the declaration executed by the 37 CFR 1.47(b) complies with 37 C.F.R. 1.497(a)-(b).

With regard to item (5), the copy of non-signing inventor Wolfgang Höss's employment agreement satisfies the requirements of 37 C.F.R. 1.47(b). However, petitioner has not provided a statement by a person having firsthand knowledge showing that that the invention was made by the employee while employed by the 37 C.F.R. 1.47(b) applicant. MPEP 409.03(f).

With regard to item (6), petitioner has demonstrated that irreparable harm will result if the application is not permitted to proceed.

Based on the totality of the evidence currently of record, it would not be appropriate to consider the requirements of 37 CFR 1.47(b) to have been satisfied.

CONCLUSION

Applicant's petition requesting acceptance of the application without the signature of the inventor is **DISMISSED**, without prejudice, for the reasons described *supra*.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request

should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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